REMARKS

At the time of the Office Action dated December 27, 2005, claims 1-14 were pending and rejected in this application. Claim 1 has been amended to address a clerical error. Applicant submits that the present Amendment does not generate any new matter issue.

CLAIMS 1-14 ARE REJECTED UNDER 35 U.S.C. § 102 AS BEING ANTICIPATED BY SCHOLZ ET AL., U.S. PATENT PUBLICATION NO. 2003/0078949 (HEREINAFTER SCHOLZ)

On pages 3-10 of the Office Action, the Examiner asserted that Chase discloses the invention corresponding to that claimed. This rejection is respectfully traversed.

The factual determination of anticipation under 35 U.S.C. § 102 requires the identical disclosure, either explicitly or inherently, of each element of a claimed invention in a single reference.[1] As part of this analysis, the Examiner must (a) identify the elements of the claims, (b) determine the meaning of the elements in light of the specification and prosecution history, and (c) identify corresponding elements disclosed in the allegedly anticipating reference.[2] This burden has not been met. Moreover, the Examiner has failed to clearly designate the teachings in Scholz being relied upon the statement of the rejection. In this regard, the Examiner's rejection under 35 U.S.C. § 102 also fails to comply with 37 C.F.R. § 1.104(c).[3]

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[1] In re Rijckaert, 9 F.3d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993); Lindermann Maschinenfabrik GMBH v. American Hoist & Derrick Co., 730 F.2d 1452, 221 USPQ 481 (Fed. Cir. 1984).
[2] Lindermann Maschinenfabrik GMBH v. American Hoist & Derrick Co., supra.
[3] 37 C.F.R. § 1.104(c) provides:

> In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly

Despite this requirement, the Examiner's statement of the rejection simply consists of the Examiner repeating, almost word-for-word, each of the recited claims and asserting that the entire claim is disclosed by certain specified passages within Scholz. The manner in which the Examiner conveyed the statement of the rejection, however, has not "designated as nearly as practicable" the particular parts in Scholz being relied upon in the rejection.

It is practicable for the Examiner, for each of the claimed elements, to specifically identify each feature within Scholz being relied upon to teach each of the particular claimed elements. For example, the Examiner can "specifically identify" a feature, corresponding to the claimed element, within the applied prior art by identifying a reference numeral associated with the feature. In addition to, or alternatively, the Examiner may cite to a brief passage (i.e., 1 or 2 lines or even a portion of a line) within the applied prior art that identifies the feature that corresponds to the claimed element. However, merely citing a long passage or an entire paragraph to disclose a single (or multiple) claimed elements does not designate "as nearly as practicable," the particular features within Scholz being relied upon by the Examiner in the rejection.

Applicant also notes the Examiner reference to M.P.E.P. § 2143 in the paragraph spanning page 9 and 10 of the Office Action, in which the Examiner asserted that "any citations to specific, [sic] pages, columns, lines, or figures in the prior art references and any interpretation

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as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.

of the references should not be considered to be limiting in any way." This assertion, however,

is not supported by M.P.E.P. § 2143, entitled "Rejection Over Prior Art's Broad Disclosure

Instead of Preferred Embodiments." Moreover, notwithstanding that "patents are relevant as

prior art for all they contain," the Examiner must still meet the requirements of 37 C.F.R. §

1.104(c).

The importance of the specificity requirement of 37 C.F.R. § 1.104(c) is evident in

M.P.E.P. § 706.07, which states:

> The examiner should never lose sight of the fact that in every case the applicant is entitled to a full
> and fair hearing, and that a clear issue between applicant and examiner should be developed, if
> possible, before appeal.

A clear issue, however, cannot be developed between Applicant and the Examiner where the

basis for the Examiner's rejection of the claims is ambiguous. The Examiner's "analysis"

provides little insight as to (i) how the Examiner is interpreting the elements of the claims and

(ii) what specific features within Scholz the Examiner believes identically discloses the specific

elements (and interactions between elements) recited in the claims. By failing to specifically

identify those features within Scholz being relied upon in the rejection, the Examiner has

essentially forced Applicant to engage in mind reading and/or guessing to determine how the

Examiner is interpreting the elements of the claims and what specific features within Scholz the

Examiner believes identically disclose the claimed invention. Applicant also notes that any

continuing disagreement between Applicant and the Examiner as to whether or not a particular

claimed feature is disclosed by Scholz is a direct result of a lack of specificity by the Examiner in

the statement of the rejection.

<u>Claim 1</u>

Independent claim 1 recites the following features:

> validation processor configured with a prototype interface for receiving both a field validation pattern and also form based input to be validated against said field validation pattern; and,
>
> a validation script library packaging said validation processor

To teach these limitations the Examiner cited paragraphs [0116] and [0131] of Scholz and asserted that "a 'form processor' as a separate component or module" and "the custom tags, for the validation, implemented as an object model stored in the tag library."

For ease of reference, paragraphs [0116] and [0131] of Scholz are reproduced below:

[0116] Alternatively, a non-Java-oriented programming technique may be used as the form processor 808. For example, the form processor 808 may be a separate component or module (e.g., software, firmware, and/or hardware) that analyzes the form definitions 806 to identify the custom tags. These custom tags are then replaced with the corresponding HTML code, validation code, and optionally a call to the corresponding validation code.
[0131] In one implementation, the custom tags are implemented as an object model (e.g., stored in the tag library 816). An exemplary object model to be used by the form tags to store attributes for each input type and the overall form is illustrated in the following tables. An initial object is the FormCollection object, illustrated in Table 16:

The features recited in claim 1 include: (i) a validation processor; (ii) a prototype interface; (iii) a field validation pattern; (iv) form based input; (v) a validation script library; and (vi) all the interactions between features (i)-(v). The Examiner, however, only asserted that Scholz discloses a form processor 808 and custom tags stored in a tag library 816.

Moreover, the Examiner's rejection is ambiguous as to what particular features in Scholz allegedly disclose the particular features recited in the claims. Assuming, for sake of argument,

that the Examiner is asserting that the form processor 808 identically discloses the claimed

validation processor and the tag library 816 identically discloses the claimed validation script

library, then these features fail to identically disclose the claimed invention. As illustrated in

Fig. 8 of Scholz the tag library 816 is not "packaging" the form processor, as recited in claim 1.

Instead, the tag library 816 is separate from the form processor 808. Moreover, the form

processor 808 does not <u>receive</u> "form based input" (i.e., input received in a form), as recited in

claim 1. Instead, the form processor 808 receives input form definitions 806 from which the

form processor 808 creates output form definitions 818 (see Fig. 8 of Scholz).

The Examiner has also failed to establish that Scholz teaches "a prototype interface"

within the validation processor that receives "a field validation pattern." Therefore, for all the

reasons stated above, Applicant submits that Scholz fails to identically disclose the claimed

invention, as recited in claim 1, within the meaning of 35 U.S.C. § 102.

<u>Claim 2</u>

Claim 2 recites the following features: (i) a library reference; (ii) markup; (iii) a form;

(iv) at least one form based input field programmed for validation using said validation

processor; (v) a function call; (vi) a configuration for passage a reference; (vii) a value; and (viii)

all the interactions between these features and also the features recited in claim 1. However, to

teach the limitations recited in claim 2, the Examiner only cited paragraph [0109] to teach

"validation by reference to the validation code" and paragraphs [0131]-[0132] to teach "custom

tag library and the FormCollection object." Similar to the rejection of claim 1, the Examiner's

statement of rejection is ambiguous as to what particular features in Scholz allegedly disclose the

particular features recited in the claims. Moreover, it is readily apparent that the Examiner has

not established that Scholz identically discloses each of the limitations recited in claim 2 because

there are more limitations recited in claim 2 than the features mentioned by the Examiner in the

statement of the rejection.

Notwithstanding the Examiner's continued lack of specificity and comprehensiveness in

alleging that the claimed limitations are identically disclosed in Scholz, it is readily apparent that

even those features identified by the Examiner do not identically disclose the limitations recited

in the claims. For ease of reference, paragraph [0019] is reproduced below:

> [0119]   Custom Form Tag: The custom form tag extends the HTML form tag by 10 providing
> automated form validation creation. This tag also supports existing HTML form tag attributes. The
> custom form tag is illustrated in Table 4.

The above-cited paragraph refers to custom tags, which Scholz has identified with reference

numeral 802 (3rd sentence in paragraph [0104]). Notwithstanding the custom tags are replaced

by executable code from the tag library 816 (see paragraphs [0106]-[0107]), the markup (i.e., the

input form definitions 806) in which the custom tags 802 are found (see paragraph [0104]), does

not "[define] a form having at least one form based input field programmed for validation," as

recited in claim 2.

Regarding the Examiner's citation of paragraphs [0131]-[0132] to teach "custom tag

library and the FormCollection object," these features do not identically disclose "a function call

to said validation processor further disposed in said markup, said function call having a

configuration for passing a reference to a value in said at least one form based input field for

validation in said validation processor," as recited in claim 2. As illustrated in Fig. 8 of Scholz,

the markup (i.e., the input form definitions 806) does not include a function call to the validation

processor (i.e., form processor 808). Therefore, for all the reasons stated above, Applicant

submits that Scholz fails to identically disclose the claimed invention, as recited in claim 2,

within the meaning of 35 U.S.C. § 102.

Claim 3

Similar to claim 3, the markup (i.e., the input form definitions 806) does not include

function calls to the validation processor (i.e., form processor 808). Therefore, Applicant

submits that Scholz fails to identically disclose the claimed invention, as recited in claim 2,

within the meaning of 35 U.S.C. § 102.

Claims 4 and 5

Since Scholz fails to identically disclose the claimed function call, Scholz cannot disclose

a validation shell function encapsulating the function call.

Claims 6 and 11

Regarding independent claims 6 and 11, the Examiner generally cited paragraphs [0092]-

[0175][4] to teach "retrieving input, passing the input value, and validating the retrieved value

according to a valuation pattern within the content browser. The Examiner specifically cited

paragraph [0092] as teaching "the validation with a markup language, HTML and/or XML, in a

client-side valuation.). For ease of reference, paragraph [0092] is reproduced below:

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[4] Paragraphs [0092]-[0175] constitute pages 11-23 of Scholz, and is another example of the Examiner failing to
designate, as nearly as practicable, the particular parts in Scholz being relied upon in the rejection

[0092]   Users are able to input requests to an application via a user interface that presents one or more forms to the user, each form having one or more data input fields (e.g., text areas, user-selectable check boxes or buttons, etc.). These data inputs are predominately referred to herein as user inputs, although the inputs can alternatively come from elsewhere (e.g., from another application or component). For many forms, the application developer desires to place restrictions on the data that can be input to the fields of the form. An automatic input validation technique is used that allows forms with input fields to be automatically generated to include input validation for one or more of the input fields. Forms can be automatically generated in any of a wide variety of languages, and in one embodiment are generated as conventional pages (documents) of a conventional markup language such as the well-known HyperText Markup Language (HTML) or the well-know extensible Markup Language (XML). The form itself includes the validation code and thus performs the validation at the client (referred to as client-side validation).

One of the key differences between the claimed invention, as recited in claims 6 and 11 (or any of the other claims), and the teachings of Scholz is found in the last sentence of paragraph [0092], which states that "[t]he form itself includes the validation code and thus performs the validation at the client (referred to as client-side validation)."

As illustrated in Fig. 2 of Applicant's disclosure and recited in the claims, the script validation library 210, which includes the validation process, is separate from the form 230. For example, claims 6 and 11 recite that "a value ... from a form" is retrieved and the "retrieved value along with a validation pattern" is passed "to a validation process disposed within a lightweight validation library." Thus, the claims recite that the validation process is separate from the form, whereas Scholz teaches that the form itself performs the validation. Therefore, Applicant submits that Scholz fails to identically disclose the claimed invention, as recited in claims 6 and 11, within the meaning of 35 U.S.C. § 102.

Claim 10

Regarding independent claim 10, the Examiner identically repeated, word-for-word, the statement of the rejection presented with regard to independent claim 6. Applicant notes,

however, that claim 10 is substantially different the claim 6, yet this difference has not been

reflected in the Examiner's statement of the rejection. Notwithstanding this ambiguous and

incomplete rejection, Applicant incorporates herein the arguments previously presented with

regard to claim 6 as also applying to claim 10. Claim 10 recites that the validation process is

separate from at least one form based input field in markup, whereas Scholz teaches that the

form/markup itself performs the validation. Thus, Applicant submits that Scholz fails to

identically disclose the claimed invention, as recited in claim 10, within the meaning of 35

U.S.C. § 102.

Therefore, for the reasons stated above, Applicant respectfully solicits withdrawal of the

imposed rejection of claims 1-14 under 35 U.S.C. § 102 for anticipation based upon Scholz.

Applicant has made every effort to present claims which distinguish over the prior art,

and it is believed that all claims are in condition for allowance. However, Applicant invites the

Examiner to call the undersigned if it is believed that a telephonic interview would expedite the

prosecution of the application to an allowance. Accordingly, and in view of the foregoing

remarks, Applicant hereby respectfully requests reconsideration and prompt allowance of the

pending claims.

Although Applicant believes that all claims are in condition for allowance, the Examiner

is directed to the following statement found in M.P.E.P. § 706(II):

> When an application discloses patentable subject matter and it is apparent from the
> claims and the applicant's arguments that the claims are intended to be directed to such patentable
> subject matter, but the claims in their present form cannot be allowed because of defects in form or
> omission of a limitation, the examiner should not stop with a bare objection or rejection of the

claims. The examiner's action should be constructive in nature and when possible should offer a definite suggestion for correction.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 09-0461, and please credit any excess fees to such deposit account.

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